UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Cristi Nesbitt Ullmann and Lorin Evan Ullmann

Appeal No. 2006-1287
Application No. 10/047,116

ON BRIEF

Before RUGGIERO, BARRY, and BLANKENSHIP, *Administrative Patent Judges.*
BARRY, *Administrative Patent Judge.*

A patent examiner rejected claims 1-28. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

I. BACKGROUND

The invention at issue on appeal concerns the recording of World Wide Web ("Web") browsing sessions for subsequent use, review, and analysis. (Spec. at 1.) High-end professionals and physically impaired people may have others conduct their Web browsing and searching. The value of the searches, however, is limited by the searcher's understanding of the problem to be searched. A resulting list of Web documents or Uniform Resource Locations ("URLs") selected by the searcher via hyperlink threads, furthermore, leaves insufficient information as to which hyperlink

threads the searcher has chosen to ignore or discard. In addition, the physically impaired user has problems navigating to his documents of choice in a search lists or navigating to appropriate URLs. (*Id.* at 4.)

An understanding of the appellants' invention can be achieved by reading the following claim.

> 11. In a Web communication network with user access via a plurality of data processor controlled interactive receiving display stations for displaying received hypertext documents of at least one display page containing text, images and a plurality of embedded hyperlinks, each hyperlink being user selectable to access and display a respective linked hypertext document, a method for generating surrogate Web browsing sessions comprising:
>
> enabling a user to interactively navigate the Web through a sequence of linked hypertext documents in a browsing session at a receiving display station;
>
> recording on a real-time basis said interactive navigation of said user in said browsing session;
>
> enabling a subsequent user to follow the path of said recorded navigation on a real-time basis in a surrogate browsing session on a display device;
>
> enabling said subsequent user following said path of said recorded navigation In said surrogate session to modulate the real-time of said navigation on said display device; and
>
> enabling said subsequent user to select a recorded but previously unselected hyperlink to thereby access a linked hypertext document.

Claims 1-3, 7, 11-13, 17, 19-21, and 25 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. ("6,535,909"), which incorporates by reference U.S. Patent No. 5,944,791 ("Scherpbier"). Claims 4-6, 8-10, 14-16, 18, 22-24, and 26-28 stand rejected under § 103(a) as obvious over Rust and U.S. Patent No. 6,546,405 ("Gupta").

II. OPINION

"Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween." *Ex parte Muresan*, No. 2004-1621, 2005 WL 951659, at *1 (Bd.Pat.App & Int. Feb 10, 2005). Although the examiner admits, "Rust fails to explicitly state the subsequent user selecting a recorded but previously unselected hyperlink as recited in the claims," (Examiner's Answer at 4), he concludes "This is an obvious action for the user to take and is taught by any browsing session." (*Id.* at 8.) In addition, the examiner alleges, "Obviousness is also supported by the reference Scherpbier which is incorporated by reference into Rust which discusses recording all of the hyperlinks, selected and unselected, within a previously accessed website, transmitting them to a subsequent user, the co-pilot, and allowing that co-pilot to select them as seen *supra.*" (*Id.*) The appellants argue that "there is nothing in Rust to suggest that during a subsequent playback session, there can be an interactive selecting of an unselected unused hyperlink from the previously

recorded Web browsing session to thereby access the linked hypertext (Web) document." (Appeal Br. at 6.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Here, claims 1, 11, and 19 recite in pertinent part the following limitations: "enabling said subsequent user to select a recorded but previously unselected hyperlink to thereby access a linked hypertext document."

B. OBVIOUSNESS DETERMINATION

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (Bd.Pat.App & Int. 2004). "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d

1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). Of course, "deficiencies of the cited references cannot be remedied by . . . general conclusions about what is 'basic knowledge' or 'common sense' to one of ordinary skill in the art." *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Here, although the examiner concludes that enabling a subsequent user to select a recorded, but previously unselected, hyperlink to thereby access a linked hypertext document "is an obvious action for the user to take and is taught by any browsing session," (Examiner's Answer at 8), he offers no evidence to support that conclusion. To the contrary, he admits that Rust fails to teach the feature. (*Id.* at 4.) Furthermore, Rust belies the examiner's allegation that "Scherpbier . . discusses recording all of the hyperlinks," (*id.* at 8), by explaining that "[t]he problem," (col. 1, l. 61) with Scherpbier is the latter's inability to enable "the user of the first computer ('Presenter') to be able to record and save the presentation so that the one or more second computers ('Client') can view the presentation at a later time." (*Id.* at ll. 61-65.)

Absent a teaching or suggestion of enabling a subsequent user to select a recorded, but previously unselected, hyperlink to thereby access a linked hypertext document, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejection of claims 1, 11, and 19 and of claims 2, 3, 7, 12, 13, 17, 20, 21, and 25, which depend therefrom.

Furthermore, the examiner does not allege, let alone show, that the addition of Gupta cures the aforementioned deficiency of Rust. Therefore, we reverse the rejection of claims 4-6, 8-10, 14-16, 18, 22-24, and 26-28, which depend from claims 1, 11, and 19.

III. CONCLUSION

In summary, the rejections of claims 1-28 under § 103(a) are reversed.

REVERSED

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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